

**REMARKS**

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

**A. Status of the Claims and Explanation of Amendments**

Claims 1-44 are currently pending. By this paper, claims 1-3, 5-7, 10-12, 16-27, 30-32, 36-40, and 42-44 are amended. Claim 41 is cancelled without prejudice or disclaimer. This listing of claims will replace all prior listings of claims in the application. No new matter will be added to this application by entry of these amendments. Entry is respectfully requested.

Applicants have amended claims 42 and 43 herein to now recite "in response to a designation of a format change instruction which is different from said image sensing instruction." Support for these amendments can be found throughout the Specification, for example in Figures 2 and 3 and page 19, line 23 – page 24, line 20.

Applicants have also amended claim 44 to include "medium," and properly depend from claim 43, as suggested in the 12/28/06 Office Action at page 2. These amendments are not made for any substantial reason related to patentability (§§ 102, 103). Withdrawal of the objections to claim 44 is respectfully requested.

Claims 1-5, 7-8, 10, 12-15, 21-25, 27-28, 30, 32-35, and 41-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2001/0020979 to Lathrop. Claims 6, 9, 16, 26, 29, and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lathrop, and further in view of European Patent Application No. 1,152,589 to Sarbadhikari et al. ("Sarbadhikari"). Claims 11 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lathrop, and further in view of U.S. Patent No. 6,031,964 to

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Anderson. Claims 17-19 and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lathrop, and further in view of European Patent Application No. 1,133,167 to Nakamura et al. ("Nakamura"). Finally, Claims 20 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lathrop. Applicants respectfully traverse these rejections.

**B. Claims 1-40, and 42-44 are patentably distinct over Lathrop and/or Sarbadhikari, Anderson, or Nakamura either alone or in combination**

Applicants respectfully traverse the rejections of claims 1-40, and 42-44 over the cited references. Briefly, the cited references, alone or in combination, fail to teach, disclose, or suggest all of the claim elements of Applicants' claims. Accordingly, the rejection should be traversed. MPEP § 2143

Applicants' Claim 42 as amended recites, *inter alia*,

An image sensing apparatus comprising: an image sensor ... a recording unit ... and a controller that controls to record on said recording medium the sensed image in a first format in addition to the same sensed image in a second format, different from the first format, which is designated in advance, in response to a designation of a format change instruction which is different from said image sensing instruction when the format change instruction is designated by a user within a predetermined period after sensing the image.

Applicants claim 43 as amended recites similar features to claim 42 as described above.

Lathrop is directed to "An electronic still camera [which] includes an image sensor for capturing an original image and generating image signals corresponding to the captured original signal ..." [Abstract]. The Office Action alleges that Lathrop's paragraphs

[0017] and [0018] correspond to the claimed “controller that controls to record.” [12/28/2006 Office Action, p. 3].

Lathrop discloses a camera which temporarily stores in memory an image in TIFF format that is incrementally processed into a JPEG format. This “incremental image processing” automatically performs JPEG processing on the image in TIFF format, and stores the processed image in JPEG format. [Lathrop, ¶¶0017-19]. Lathrop also discloses capturing a new image while performing JPEG processing. In such case, the JPEG processing is interrupted, and capture of the new image is performed prior to completion of the JPEG processing, and the newly captured image is temporarily stored in TIFF format.

In Lathrop, as described above, every image stored in TIFF format undergoes the JPEG processing and is eventually stored in JPEG format *without* the user instructing the apparatus to do so. The only occasion in which automatic image processing is actuated or influenced by the user is if the user decides to take a new picture while the JPEG processing is in progress, in which case a new image is also stored in TIFF format in addition to the image stored in JPEG format in response to the image capture instruction. [See Lathrop, ¶0019]. Furthermore, according to Lathrop, the image stored in TIFF format in response to the image capture instruction is different from the image stored in JPEG format. In contrast, amended claim 42 recites, “a controller that controls to record ... the sensed image in a first format in addition to the same sensed image in a second format ... which is designated in advance, in response to a designation of a format change instruction *which is different from said image sensing instruction when the format change instruction is designated by a user....*” (emphasis

added). Thus, the format change instruction is separate and distinct from the image sensing instruction, and the image stored in the two formats is the same.

Accordingly, Applicants submit that Lathrop neither discloses nor suggests a “controller that controls to record on said recording medium the sensed image in a first format in addition to the same sensed image in a second format,” as recited in Applicants’ amended claim 42. Therefore, Applicants respectfully request this ground of rejection be withdrawn. Applicants respectfully submit that independent claim 43, reciting similar features to claim 42 as discussed above, is patentably distinct for at least similar reasons. Therefore, Applicants respectfully request this ground of rejection be withdrawn.

Further, Sarbadhikari, Anderson, or Nakamura, either taken alone or in combination, do not disclose at least a “controller that controls to record,” as recited in Applicants’ claims 42 and 43, and thus do not remedy the deficiencies of Lathrop.

Reconsideration and withdrawal of rejections of claims 42 and 43 under 35 U.S.C. § 102(e) is respectfully requested.

Applicants have chosen in the interest of expediting prosecution of this patent application to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as an admission that the cited documents are, in fact, prior art. Likewise, Applicants have not specifically addressed the rejections of each of the dependent claims. Applicants respectfully submit that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims are also in condition for allowance. Applicants, however, reserve the right to address such rejection of the dependent claims in the future as appropriate.

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**CONCLUSION**

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested.

Should an extension of time be required for the timely submission of this paper, such extension is hereby petitioned, and the Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 13-4500, Order No. 1232-5148.

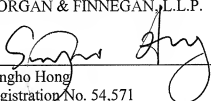
In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1232-5148.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 27, 2007

By: \_\_\_\_\_

  
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